

REMARKS

Claims 16-28 are pending.

Claims 16-24 are rejected under 35 U.S.C. §102(e) over Kumar et al., U.S. Patent No. 6,476,220. Reconsideration and withdrawal of this rejection, and declaration of an interference, are respectfully requested. 2136.05

As noted in the Office Action, the same process is being claimed in claims 16-24 and the claims of the Kumar et al. patent. This is also true of claims 16-28 as amended and added herein. As discussed below, claims 16-28 are otherwise allowable. Attached is a Showing under 37 C.F.R. §1.608(b), establishing that Applicants are *prima facie* entitled to a judgment relative to the patentee. Accordingly, the 35 U.S.C. §102(e) rejection should be withdrawn, and an interference should be declared. See MPEP §2308.01.

Claims 16-24 are provisionally rejected for obviousness-type double patenting over claims 1-6 of co-pending Application No. 10/208,879. Upon entry of the above amendments, the provisional double patenting rejections in both applications will be the only rejections remaining in those applications. Accordingly, the Examiner is requested to withdraw the rejection in the present application (i.e., the application with the earlier filing date). See MPEP §804.I.B.

Claim 20 is rejected under 35 U.S.C. §112, second paragraph, for lack of antecedent basis in claim 19 for "said organic solvent." Claims 19 and 20 have been amended to clarify the antecedent basis for the terms of claim 20. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

Claim 21 has also been editorially amended, without changing its scope, to avoid a further 35 U.S.C. §112, second paragraph rejection.

Claims 19 and 21 are rejected under 35 U.S.C. §112, first paragraph, on the grounds that the provision of performing the reaction in "any solvent" is allegedly slightly broader

than the specification-described performance of the reaction in an organic solvent.

Applicants respectfully disagreed with this ground for rejection. However, claim 19 is amended above to recite that the reaction is performed in an organic solvent. Accordingly, it is respectfully submitted that the rejection is overcome, and its reconsideration and withdrawal are respectfully requested.

Claims 16, 17, 19, 20, 22 and 23 are rejected under 35 U.S.C. §112, first paragraph, on the grounds that they do not include a reaction temperature limitation. Claims 16-18 and 22-24 are rejected under 35 U.S.C. §112, first paragraph, on the grounds that they refer to the 2-thiofuroic acid being "in a solvent."

Initially, it is noted that claim 21 is not rejected on either ground. In addition, new claims 25-28 (which otherwise respectively correspond to claims 16, 17, 22 and 23) include a reaction temperature of 20-50°C and recite that the 2-thiofuroic acid is in an organic solvent. Accordingly, it is respectfully submitted that claims 21 and 25-28 are in condition for allowance.

The rejections are respectfully traversed as to the remaining claims. It is respectfully submitted that the claims fully comply with 35 U.S.C. §112, first paragraph.

First, the specification does not describe either limitation as "an essential or critical feature of the invention." See MPEP §2163.05.I. To the contrary, the specification makes clear that the subject limitations are merely preferred features of the invention.

For example, page 1, lines 1-9, page 3, lines 5-9 and page 3, lines 10-20 do not refer to either of the limitations. The Summary of the Invention on page 3 also does not mention 2-thiofuroic acid being in an organic solvent, and page 5, lines 3-4 specifically note that the use of 2-thiofuroic acid in an organic solvent is only "one embodiment of the present invention." Examples I-III show that the reaction is begun at 10°C, which is outside the temperature range specified in the Office Action.

Thus the specification clearly discloses the claimed process without the subject temperature limitation, and the use of 2-thiofuroic acid in a solvent, and neither the temperature limitation nor the "organic" limitation on the solvent is disclosed to be an essential or critical feature of the invention in the specification. Accordingly, in accordance with MPEP §2163.05.I., the 35 U.S.C. §112, first paragraph rejections should be reconsidered and withdrawn.

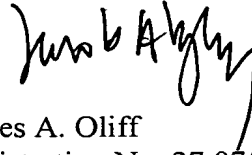
In addition, it is noted that substantially identical grounds for rejection could be applied to the Kumar 220 patent. Accordingly, approval of the Technical Center Director would be required for this rejection to be maintained.

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diff. spec*

In view of the above amendments and remarks, and the attached Showing under Rule 608(b), it is respectfully submitted that this application is in condition for allowance. Thus, reconsideration and withdrawal of all of the rejections, and indication of allowability of claims 16-28, is respectfully requested. Furthermore, it is respectfully requested that an interference be declared with the Kumar et al. patent, in which present claim 16 is the count of the interference, and with claims 16-28 of the present application and claims 1-3 of the Kumar et al. patent designated to correspond to the count.

Should there be any questions concerning this matter, please telephone the undersigned at the number set forth below.

Respectfully submitted,



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Attachment:
Rule 608 Showing

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